



George J. Vlahos
8549 Heather Court
St John, IN 46373

In re Application of Vlahos	:	
Application No. 10/064,010	:	Letter
Filing Date: June 4, 2002	:	
For: Light Therapy Equipment	:	

This is a letter in response to a telephone conversation between Petitions Attorney Steven Brantley and inventor/petitioner George Vlahos on August 28, 2008.

During the telephone conversation, petitioner requested this letter be typed in a font size larger than normal. Therefore, this letter has been typed in font size 14 in order to accommodate petitioner.

Background

The Office mailed a final Office action on January 17, 2007. The Office action set a three-month shortened statutory period for reply.

A reply to the Office action was not received and the application became abandoned on April 18, 2007.

A Notice of Abandonment was mailed September 6, 2007.

A petition to withdrawn the holding of abandonment was filed February 25, 2008. Petitioner alleged a reply to the final Office action was filed July 17, 2007.

Petitioner alleged the reply consisted of:

- (1) A credit card payment authorization form,
- (2) A "Petition for Extension of Time" page,
- (3) A "Pre-Appeal Brief Request" page,
- (4) A "Notice of Appeal" page, and

- (5) A one page letter dated July 17, 2007, beginning with the language, "In response to the final rejection issued on January 17, 2007."

The petition was submitted with payment of \$525 for a three-month extension of time and \$235 for a notice of appeal.

The Office mailed a decision dismissing the February 25, 2008 petition on June 6, 2008. The decision stated,

The petition was accompanied by a total of \$760 for the extension of time fee and notice of appeal fee. Since the petition is being dismissed, the \$760 is refundable. Petitioner may either request a refund of the \$760 or, as discussed below, apply the \$760 towards the fee required for a petition under 37 CFR 1.137(b) to revive an application.

Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (A) A proper reply to the outstanding final Office action,
- (B) The required petition fee of \$770, and
- (C) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

As to item (A) above, if petitioner wishes to file a petition under 37 CFR 1.137(b) and for the reply to be a Notice of Appeal, petitioner should file a new Notice of Appeal, a new Pre-Appeal Brief request, and \$255 for the Notice of Appeal.

As to item (B) above, petitioner may wish to submit an additional \$10 and request the \$760 submitted on February 25, 2008, be applied towards the fee.

A copy of a blank petition under 37 CFR 1.137(b) form is enclosed for petitioner's convenience. A PDF "fillable" version of the form can be found at: http://www.uspto.gov/web/forms/sb0064_fill.pdf.

On August 28, 2008, petitioner spoke with Petitions Attorney Steven Brantley via telephone. Petitioner expressed a need for clarification of the prior decision and several related matters.

Discussion

During the telephone conversation, petitioner indicated a desire to file a petition under 37 CFR 1.137(b). This letter includes a discussion of steps that should be taken if petitioner wishes to file a petition under 37 CFR 1.137(b).

Step 1: Completion of the Petition Under 37 CFR 1.137(b) Form

A petition form is attached. During the August 28, 2008, petitioner indicated he was encountering a great deal of difficulty in determining how to complete the form.

The attached petition form is partially completed. Petitioner only needs to take the following two steps to complete the form:

- (1) Sign the form, and
- (2) Add the date the form is signed.

Step 2: Providing an Explanation for the Delay in the Submission of the Petition.

Almost 15 months have passed since the Office mailed the June 6, 2008 decision and almost two years have passed since the Office mailed a Notice of Abandonment.

Any petition under 37 CFR 1.137(b) should be accompanied by a letter fully discussing the delay in the filing of the petition from the date the Office mailed the June 6, 2008 decision until a petition under 37 CFR 1.137(b) is actually filed.

The reason(s) petitioner delayed in the filing of a petition under 37 CFR 1.137(b) will be relevant when determining if the petition should be granted.

MPEP 711.03(c)(II)(D) states,

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137:

- (A) the delay in reply that originally resulted in the abandonment;
- (B) the delay in filing an initial petition pursuant to 37 CFR 1.137 to revive the application; and
- (C) the delay in filing a grantable petition pursuant to 37 CFR 1.137 to revive the application.

As discussed above, the abandonment of an application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as “unintentional” within the meaning of 37 CFR 1.137(b), where the applicant deliberately permits the application to become abandoned. *See Application of G*, 11 USPQ2d at 1380. Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as “unintentional” within the meaning of 37 CFR 1.137(b). An intentional delay resulting from a deliberate course of action chosen by the applicant is not affected by:

- (A) the correctness of the applicant’s (or applicant’s representative’s) decision to abandon the application or not to seek or persist in seeking revival of the application;
- (B) the correctness or propriety of a rejection, or other objection, requirement, or decision by the Office; or
- (C) the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision not to seek or persist in seeking revival.

Step 3: Payment of the Required Petition Fee

The current fee for a petition under 37 CFR 1.137(b) is \$810. Therefore, the petition under 37 CFR 1.137(b) must include payment of \$810. In the alternative, the petition can include payment of \$50 and request the payment of \$760 on February 25, 2008, be applied towards the \$810 fee.

Step 4: Filing a Proper Reply to the Outstanding Final Office Action

The petition to revive the application must include a proper reply to a final rejection in the form of:

- (1) an amendment which *prima facie* places the case in condition for allowance,
- (2) a Notice of Appeal and the required fee,
- (3) a RCE, or
- (4) a continuation application.

As to (1), applicant does not have a "right" to amend any finally rejected claims, add new claims after a final rejection, or reinstate previously canceled claims. However, the Office will normally consider an amendment a proper reply to an Office action if it *prima facie* ("on its face") places the application in condition for allowance. In other words, the amendment must merely cancel claims which have been rejected, adopt examiner suggestions, or in some other way require only a cursory/brief review by the examiner. If an amendment requires further searching by an examiner, it will generally not be accepted. An example of an acceptable amendment:

- a. Examiner files final rejection which states, "Claim #2 is rejected, however if the word 'plural' were deleted then the claim would be acceptable";
- b. An amendment is filed which deletes the word "plural;" and
- c. The amendment on its face is allowable, no further work by the examiner is required.

The above is only an example.

As to (2), petitioner may file a Notice of Appeal with the fee of \$270. Petitioner filed a copy of a Notice of Appeal and Pre-Appeal Request for Review with the petition filed February 25, 2008. However, both papers were mostly illegible. Therefore, if petitioner wishes for the reply to the final Office action to be a Notice of Appeal and Pre-Appeal Request for Review, a new copy of each form should be filed. A Notice of Appeal form and a Pre-Appeal Request for Review form are attached.

As to (3), a RCE and the required fee of \$405 can be filed. A RCE is basically a request to continue prosecution of the application. A RCE must be accompanied by a "submission" which is usually in the form of an amendment. The amended claims are then examined by the examiner. The amendment, on its face, does NOT have to place the application in condition for allowance in order for the amendment to be considered on the merits. If the amendment requires additional work or research by the examiner, then the work and research will be done. Unlike "an amendment after final" where the applicant does not have the "right" to file an amendment, an applicant does have such a right when the amendment is filed with a RCE. To file a RCE requires an additional fee of \$405 (for a small entity) plus any applicable additional claim fees. A copy of a form that can be used is enclosed for petitioner's convenience.

As to (4), a continuation application under 37 CFR 1.53(b) may be filed. Although a continuation application is not technically a reply to the final office action, the Office has determined a continuation application will be treated as a proper reply for purposes of reviving an application for copendency under 37 CFR 1.137.

Legal Assistance

Although the Office wishes to provide petitioner with assistance, the Office is unable to serve as petitioner's attorney.

The Office strongly suggests petitioner consider obtaining legal counsel to assist petitioner in reviving and prosecuting the application. Petitioner lives outside of Chicago. A search of registered attorneys and agents practicing in Illinois using a website (<https://oedci.uspto.gov/OEDCI/>) indicates the presence of about 2,395 in Illinois with a very large number in Chicago.

Petitioner's Right to Request a Refund

Petitioner is reminded petitioner has the right not to pursue revival of the application, allow the application to remain abandoned, and request a refund of the \$760 paid February 25, 2008.

If petitioner submits \$50 for the petition under 37 CFR 1.137(b) fee and requests the \$760 be applied towards the petition fee, the total of \$810 will *not* be refundable even if the petition under 37 CFR 1.137(b) is not granted.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
 Attn: Office of Petitions

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

A handwritten signature in black ink, appearing to read 'Charles Steven Brantley', written in a cursive style.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

Enclosures: Partially completed form for petition under 37 CFR 1.137(b)
Notice of Appeal form
Pre-Appeal Request for Review form
Request for Continued Examination form
Credit Card Authorization Form
Privacy Act Notice